



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/002,156	12/05/2001	Hiroshi Tomaru	Q67419	2261

7590

11/14/2003

SUGHRUE, MION, ZINN,
MACPEAK & SEAS, PLLC
Pennsylvania Avenue, N.W.
Washington, DC 20037

EXAMINER

MARKS, CHRISTINA M

ART UNIT

PAPER NUMBER

3713

DATE MAILED: 11/14/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/002,156

Applicant(s)

TOMARU ET AL.

Examiner

C. Marks

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

Claim 4 is objected to because of the following informalities: There is no antecedent basis for the phrase "The horse racing game" in line 1. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The rejections to claims 1-8 under 35 U.S.C. 112, second paragraph, have been withdrawn due to the amendment filed which clarifies the issues at hand.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagao et al. (US Patent No. 6,394,898) in view of NHL Faceoff (Sony Computer Entertainment) further in view of Dickinson et al. (US Patent No. 6,224,485).

Nagao et al. disclose a gaming machine (FIG 1, reference 10) that wherein a plurality of racing members in the form of miniature horses (FIG 1, reference 14) that each have a member name (Column 13, lines 6-9) and participate in a plurality of races (Column 1, lines 30-34). Nagao et al. disclose a name associated with every race (FIG 12, SEGA CUP) and with each horse (FIG 12).

The gaming machine of Nagao et al. also discloses a race record evaluator that is operable to evaluate race records for each racing member in accordance with race results for a set number of races (FIG 12, Column 11, lines 57-67; Column 12, lines 1-8). The evaluator is operable to display a ranking table wherein the racing members are ranked in accordance with

the race results (FIG 12, condition rating). Though the table does not explicitly disclose the display of the number of prizes acquired by each horse, the table is used to aid the user in determining handicapping factors related to each horse in order to assist the user in placing bets regarding the performance of the horses (Column 11, lines 57-67). The table discloses race information; including place finishes for the past four races the horse participated in (FIG 12). One of ordinary skill in the art could thus determine from this information the prizes associated with each place finish and henceforth the inclusion of such information in the table would have been obvious to one of ordinary skill in the art who would be motivated to make such an inclusion in order to further aid the user in determining horse performance in relation to betting.

Nagao et al. do not disclose that parts of the names assigned to the horses are based upon the registration name of a game player. Further, Nagao et al. do not disclose a special type of race wherein the race name includes part of the player name, based upon the first-place ranking of the associated horse member.

It is notoriously well known in the art that players who create characters are given the power to name the characters based upon any names they desire, including part of the player's own name. This fact is employed in video games, online role-playing games, fantasy sports management games, as well as online communication games. NHL Faceoff provides an example of this fact by disclosing a name assigner that gives the ability to a player to register his or her name in a registration screen (Create a Player, page 7) and is operable to assign the name initially register by the player to that character. The player can name the player as they wish and in the example disclosed, the name of an actual user is used. From this registration information provided by the player, the name of the user is assigned to the associated character as the character's name for use in the game. Further, the game is operable to assign a name,

which is initially registered by a player, to a character as it is disclosed that previously created players can be accessed as a RAM card holds up to 400 created players (Create a Player, page 8) thus names that are previously registered can be accessed.

Dickinson et al. disclose a gaming machine wherein a plurality of games can be played and upon the player achieving a score better than any of the previous games, the machine is operable to establish a game as special in the manner that the machine will assign the player name to the game as part of the game's name thereof (FIG 4, references 80 and 82). It is also operable to display this name as part of a special game based upon a first place ranking. Thus, the special race is selected and the player's name is assigned to the game. This will occur when the player to which the name is assigned has a score or record better than any other of the previous or current users (Abstract) thus ranking the player in first place among all the other players (Column 1, lines 58-61). Dickinson et al. further teaches that players enjoy games with such high scorer displays because for those who have achieved a high score, the display provides a record of the player's accomplishments and gives them bragging rights in the particular game until unseated (Column 1, lines 17-22). Dickinson et al. also discloses it has been found that player competition engendered by high-scorer displays can attract more frequent play of the underlying games and accordingly where such displays are incorporated in coin-operated video games, greater revenues can accrue to the owner (Column 1, lines 26-31). Further, Dickinson et al. also teach that by displaying the high-scoring players during active play, greater recognition is given to the player (Column 1, lines 47-51).

It would have been obvious to one of ordinary skill in the art to allow the characters in Nagao et al. to be named based upon a name pre-registered by the player. One of ordinary skill in the art would be motivated to make this incorporation as by allowing the default names in Nagao et al. to be changed by the player, as disclosed by NHL Faceoff, a greater amount of

personalization and ability to relate to and develop characters would be achieved. In this manner, the player would feel as though the character is truly personalized and thus the player would have a greater connection to the character as the player would feel the character is a true representation of the player, not just a default value. Further, with the continued use of this pre-registered and named player, as disclosed by NHL Faceoff, the player could repeatedly and continually access and use the character, thus furthering the excitement known to be associated with character development. It is well known in the art that by allowing the player to personalize the character, the appeal of a game that involves personalization would be a greater sense of affinity to the game by the player and a higher level of immersion of the users into the game due to the personalization. Therefore, the player would be more likely to play and continue playing the game thus creating greater revenue for the game owner.

Further, it would have been obvious to one of ordinary skill in that upon allowing the player to designate their name to be used as the name for the character, that an achievement of a best race would cause the system to further display their name as part of the name for the next segment of the game in recognition of achieving a first place in the rankings as disclosed by Dickinson et al. Thus a special race would be established which would have a name associated with the player's name as part of the race based on the pre-registered player's name (as shown desirable above through the teachings of NHL Faceoff). One of ordinary skill in the art would be motivated to incorporate this feature of Dickinson et al. into the game in order to provide recognition to the player who has achieved top status. As disclosed by Dickinson et al., players enjoy games with such high scorer displays that name the game segment after them because for those who have achieved a high score, the display provides a record of the player's accomplishments and gives them bragging rights in the particular game until unseated (Column 1, lines 17-22). Dickinson et al. also discloses it has been found that player competition

engendered by high-scorer displays can attract more frequent play of the underlying games and accordingly where such displays are incorporated in coin-operated video games, greater revenues can accrue to the owner (Column 1, lines 26-31).

Response to Arguments

Applicant's arguments filed 15 September 2003 have been fully considered but they are not persuasive.

Regarding the Applicant's arguments that the Examiner is flawed in asserting that the table discloses race information including place finishes for several race and that one of ordinary skill could determine from the information the prizes associated with each place finish, the Examiner respectfully disagrees. There is a reason the results are ranked in Nagao et al. This reason constitutes that it allows players to thus handicap the horses. Nagao et al. states that the player decides on bet information based upon this displayed information, thus one of ordinary skill in the art would understand the reasons to rank, in order to aid the player with this determination. This alone is a reason to rank. Further, one of ordinary skill in the art could determine prize information based on this information as the game is a gambling game with a standard prize and payout and from the rank information; these prizes associated with the horses finishing places could be determined.

Regarding the Applicant's arguments that the concept of naming the player with the game participant's own pre-registered name is not disclosed by NHL Playoff, the Examiner respectfully disagrees. NHL Playoff allows the character to be named after the player and then this information is stored and the character can be later accessed at which time the same name is assigned to the player based on the pre-registered information associated with the character. Though this name is manual entered the first time, when it is assigned at future accesses, it is automatically associated and assigned with the character.

Regarding the Applicant's argument that the player name is not registered until the end of the game, the Examiner asserts that this argument is based upon the reference of Dickinson alone, not in combination. As discussed above, it would be obvious in the combination of all the references that when the name would be displayed as taught by Dickinson, it would be the pre-registered name of the character as taught by NHL Faceoff.

Regarding the Applicant's argument that Dickinson does not teach or suggest the selectability recited by the amended claims, the Examiner respectfully disagrees. Dickinson teaches selectability because it is taught that only the top score of the top player is selected for display, not the score of every player. Thus, the naming of the special game is based on the selection of a top player record.

Regarding Applicant's argument that the combination of references would not be obvious, the Examiner respectfully disagrees and has provided support above for the motivation of such combinations. Further, such an argument is conclusionary as no evidence nor support has been provided as to why the combination is not obvious. A mere recitation that a combination is not obvious is not a convincing argument.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

Art Unit: 3713

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Marks whose telephone number is (703)-305-7497. The examiner can normally be reached on Monday - Thursday (7:30AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa J Walberg can be reached on (703)-308-1327. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1148.



cmm

November 4, 2003



Teresa Walberg

Supervisory Patent Examiner
Group 3700